

REMARKS

The Final Office Action mailed December 30, 2003, has been carefully considered. The present Amendment is intended to be a complete response thereto and to place the case in condition for allowance. A Petition for a one-month extension of time and Notice of Appeal and fee therefor are filed herewith.

Claims 12-14 and 16 are pending. Claims 1-11 and 15 have been cancelled without prejudice to the subject matter therein. Claims 12-14 and 16 have been amended. Claims 12 and 13 have been amended to be dependent on claim 14. Claims 14 and 16 have been amended to include all the limitations of claim 10 and to add an additional limitation. Support for the claim amendments to claims 14 and 16 are found, *inter alia*, in the specification on page 11, fourth full paragraph, and FIG. 5.

THE CLAIMS ARE NOT ANTICIPATED

Claims 10, 14, and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dunn (U.S. Patent No. 5,193,426). Applicants respectfully traverse the rejection.

To anticipate a claim under 35 U.S.C. § 102, the reference must teach every element of the claim. See MPEP § 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir.

1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Dunn fails to disclose every element of the claimed invention. In particular, with respect to claim 14, Dunn fails to disclose “a first approaching motor (83) to approach the first clamp (53C, 53D) to the second clamp (53A, 53B);” and with respect to claim 16, Dunn fails to disclose “a second approaching motor (83) to approach the third clamp (69C, 69D) to the fourth clamp (69A, 69B).” The present invention provides a motor to drive the clamps down or up in order to accommodate the workpiece W (see FIG. 5). The size of the workpiece (W) in the second direction varies from Q to R (shown in the attached annotated FIG. 5), because the workpiece (W) is notched and punched. According to the present invention, even though the size of the workpiece (W) in the second direction varies for Q to R, the first clamp (53C, 53D) can be moved to approach the second clamp (53A, 53B) in the second direction (Y), thereby enabling clamping of the workpiece(W) during punching operation, as defined by claims 14. Likewise, claim 16 also provides a motor to drive the third clamp (69C, 69D) toward the fourth clamp (69A, 69B).

Dunn discloses clamp assemblies 106 and 106a that are adjustably secured on a bar 86 by nuts 102 and 102a, a screw 105 and a clamping handle 104. However, the adjustments of the clamp assemblies are manual. No motor is provided to move the clamps. Thus, when the size of the workpiece varies, for example, by notching, an operator has to stop the machine and releases or loosens the bolt 105 or clamping handle 104 and slides the clamp 106 or 106a toward the

other clamp to accommodate the notch. This manual process is highly labor intensive and reduces productivity of the punching machine. The present invention resolves this problem and increases productivity of the punching machine even though the size of the workpiece varies. Therefore, Dunn does not anticipate the invention as claimed. Accordingly, Applicants respectfully request withdrawal of the rejection.

THE CLAIMS ARE NOT OBVIOUS

Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious over Dunn in view of Graf et al. (U.S. Patent No. 3,448,645). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2143.

The references, taken alone or in combination, do not disclose or suggest Applicants' claimed invention. The deficiency of Dunn is discussed above. The Examiner relies on Graf et al. to teach a punching device where positioning devices are used to clamp and feed sheet shaped material uncoiled from a coiled material to a punching station. However, because Dunn is deficient in disclosing the combinations of elements of the independent claim, Graf et al do not cure this deficiency. Therefore, Dunn in view of Graf et al. do not render the claimed invention

obvious within the meaning of 35 U.S.C. § 103. Accordingly, the rejection should be withdrawn.

CONCLUSION

Applicants have responded to the Office Action mailed December 30, 2003. A Petition for a one-month extension of time and fee therefor are filed herewith. All pending claims are now believed to be allowable and favorable action is respectfully requested.


In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (000004.00661). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicants hereby petition under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,

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Enclosure: Annotated FIG. 5

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